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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,184	08/25/2003	Amlan Datta	129843-1099	5153
60148 7590 03/20/2008 GARDERE / JAMES HARDIE GARDERE WYNNE SEWELL, LLP 1601 ELM STREET SUITE 3000 DALLAS, TX 75201				
EXAMINER				
LE, HOA T				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
03/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/648,184

Applicant(s)

DATTA ET AL.

Examiner

H. T. Le

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 10-13, 19-24 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) 28-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 10-13, 19-24 and 27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

2. Applicant's election of claims 1-6, 8, 10-13, and 19-23 on February 1, 2008 is acknowledged. In view of Applicant's traversal, the restriction between groups I and II has been reconsidered and hereby withdrawn. Accordingly claims 1-6, 8, 10-13, 19-24 and 27 are being examined on the merits.

3. The restriction of group III claims 28-33 is maintained. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement between group I and III, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-6, 8, 10-13, 19-24 and 27 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 5, 6, and 12-16 of copending Application No. 10/684,009. Although the conflicting claims are not identical, they are not patentably distinct from each other because the only difference is in the preamble which is an intended use. The instant claims and the referenced claims are directed to the same subject matter; that is, microspheres of aluminosilicate comprising the same compositional concentrations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102/103

6. Claims 1-6, 8, 10-13, 19-24 and 27 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Beck (US 3,365,315).

Claim 1: Beck teaches a glass microballoon (i.e. microsphere) containing aluminum and silicon; therefore, the glass taught by Beck is aluminosilicate glass. The diameter of the microsphere is from 5 microns to 100 microns (col. 2, lines 52-55). The outer wall of the glass microballoon is from 10% to 20% of the diameter of the complete glass

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microballoon (col. 2, lines 58-63). Therefore, the void volume of the glass microballoon is approximately 80-90% based on the total volume of the glass microballoon. The compositional proportions of the glass comprises: up to 20 wt% of alumina, 5-25wt% of calcium oxide, 5-16 wt% of sodium oxide, and up to 10 wt% of total alkali metal oxide content. See Beck, col. 4, Table 1 and lines 39-43. Because the range of all components is within the claimed range, Beck's teaching anticipates the instant claims. In the alternative, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time of the invention to have selected the overlapping portion of the range disclosed by the prior art because overlapping ranges have been held to be a prima facie case of obvious, see In re Malagari, 182 U.S.P.Q 549.

Claim 2: See col. 1, lines 17-30 where blowing agent is discussed as conventional way of making glass microballoon.

Claim 4: The outer wall of the glass microballoon is from 10% to 20% of the diameter of the complete glass microballoon (col. 2, lines 58-63). Therefore, the void volume of the glass microballoon is approximately 80-90% based on the total volume of the glass microballoon.

Claims 2, 3, 5 and 6 are further deemed obvious because using a blowing agent to make hollow microspheres is known; and the blowing agent and binding agent as claimed are conventional materials for blowing agent and binding agent.

Claim 10: Because it's a microsphere, glass taught by Beck must have an aspect ratio of approximately 1.

Claim 11: See col. 7, lines 11-13;

Claim 13: See claim 3.

Claim 14: Silica is taught to be from 60-80 wt% while alumina is up to 20wt% (col. 4, lines 18-43); therefore its ratio $\text{SiO}_2/\text{Al}_2\text{O}_3$ is greater than one.

Claims 20-21: See col. 2, lines 52-57.

Claims 22-23: See col. 3, lines 50-73.

Claims 24 and 27: See rejection to claims 1-2 above.

7. References Gough (US 5,632,326) is cited as art of interest. Gough discloses cenospheres (Gough, col. 3, lines 14-22); however, the content of calcium oxide is below the claimed calcium oxide range.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 9:30 a.m. to 6:00 p.m., Mondays to Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. Thi Le/
H. (Holly) T. Le
Primary Examiner
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March 16, 2008